

DOCKET NO: 274674US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
OLEG STENZEL, ET AL. : EXAMINER: PARVINI, P.  
SERIAL NO: 10/542,763 :  
FILED: JANUARY 17, 2006 : GROUP ART UNIT: 1793  
FOR: HIGHLY DISPERSIBLE SILICA :  
FOR USING IN RUBBER

REPLY BRIEF

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated July 24, 2009 (Answer).

The statement of the Grounds of the Rejection (Answer at 3-13) is identical to the statement in the Office Action dated March 4, 2008, which statement was incorporated into the Final Rejection, and which has already been responded to in the Appeal Brief. The following is in reply to the Response to Argument (Answer at 13-16).

In response to Applicants' quoted excerpt from US 5,929,156 (Fultz et al), the Examiner finds that this excerpt "merely represents an opinion; no tangible or hard evidence has been submitted to show that the combination of references, specially Esch et al. in their broadest disclosure, which have substantially overlapping ranges of the claimed characteristics would not meet the limitation of instant claims under any circumstances" (Answer at 14).

In reply, the excerpt from Fultz et al (which was published in the U.S. in 1999) begins with the words “[i]t is well known that....” If the Examiner disputes that what Fultz et al describes is not well known, the burden now shifts to the Examiner to show otherwise, such as by citing conflicting prior art. The Examiner has not done so.

Regarding the Examiner’s statement about Esch et al’s “broadest disclosure,” the Examiner has not rebutted Applicants’ argument that the presently-recited ratio of Sears value  $V_2$  to BET surface area (Sears value/BET ratio), together with the other recited properties, is not believed to be achievable by the processes disclosed by the applied prior art for making their precipitated silicas. Applicants have described, and claim in process claims withdrawn from consideration, that such properties are achievable by precipitating at a constant alkali value (AV).<sup>1</sup>

Regarding the Wehmeier Declaration, the Examiner finds that it is not commensurate in scope with the claims since it compares only to Example 3 of Esch et al, and that “there is insufficient result [sic] to establish unexpected results and criticality for the measurements of instant application compared with prior art of record” (Answer at 14). The Examiner further cites case law regarding unexpected results (Answer at 14-15).

In reply, the Wehmeier Declaration compared to Example 3 of Esch et al because Example 3 thereof is the closest prior art embodiment to the presently-claimed invention. Example 3 was chosen because it is the only example in Esch et al having a Sears value within the presently-recited range. The bigger point is that the Examiner has not rebutted the expectation in the art that the greater the BET surface area, the greater the expected Sears value.<sup>2</sup> The Wehmeier Declaration was not intended to rebut a *prima facie* case of obviousness, since no *prima facie* case of obviousness has been made out. Rather, it was

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<sup>1</sup> Applicants wish to correct the typographical error in the Appeal Brief at page 4, line 7, wherein the word “constant” was incorrectly stated as “contain.”

<sup>2</sup> Applicants wish to correct the term “BET surface area” at page 6, last line of the Appeal Brief, which was incorrectly stated as “BET ratio.”

simply offered to show unexpectedly superior results when the Sears value/BET ratio is within the presently-recited range, and that a precipitated silica within the Sears value range but not within the ratio range is deficient in terms of the properties tested.

The Examiner continues to insist that the Sears value/BET ratio in Esch et al would be interpreted as from about 0.017 to about 0.57 (Answer at 15), yet all of the other evidence in Esch et al supports a finding that the higher the BET surface area, the higher the expected Sears value.

Regarding Applicants' argument that since there is no indication in Esch et al of any appreciation of the significance of the Sears value/BET ratio, there is no motivation to optimize it, and thus no evidence produced by the Examiner to show that the prior art was aware that this ratio is a result-effective variable, the Examiner simply concludes that the rejection is one under 35 U.S.C. § 103(a), that Esch et al is drawn to the same field of art, and that Esch et al discloses "substantially overlapping ranges", including what the Examiner has erroneously found is a range of 0.017 to 0.57 for Sears value/BET (Answer at 16).

In reply, this argument has already been responded to both in this Reply Brief and in the Appeal Brief.

Applicants continue to maintain that the rejections under Grounds (A) and (B) as stated in the Appeal Brief should be REVERSED, and that the rejection under Ground (C) be held in abeyance until the present claims are found to be allowable but for this ground of rejection or the copending application has been patented.

Respectfully submitted,

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